

REMARKS

This is a full and timely response to the outstanding final Office Action mailed September 21, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 7-11 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that claims 7 and 8 should identify a unique “job” identifier, and that claims 7-11 are allegedly unclear as to whether the various information identified in claims 7-11 is correlated “prior to sending.”

In response to the rejection, Applicant has amended claims 7 and 8 to replace “unique identifier” with “unique job identifier”. In view of those amendments, it is respectfully asserted that claims 7 and 8 define the invention in the manner required by 35 U.S.C. § 112.

Regarding claims 7-11, Applicant submits that the claims are not indefinite for merely not identifying whether the information recited in the claims is or is not correlated. Instead, these claims are open as to that aspect, and are therefore broad in that regard. Nothing is ambiguous, however, about, for example, “sending the unique job identifier, the pre-print information, and the post-print information to a job table on a peripheral”. By analogy, if a claim recited a “shaft” but did not state what the shaft was made of, the claim is not indefinite but instead is broad as to that aspect of the invention. In view of the above, claims 7-11 have not been amended to identify whether or not the information recited in those claims is “correlated prior to sending”.

In view of the foregoing, Applicant respectfully requests that the rejections to these claims be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-14, 16-20, 22-33, and 35-43 and have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's "admitted prior art" ("AAPA") in view of Kujirai, et al. ("Kujirai," U.S. Pat. No. 6,618,566) and further in view of Kassan, et al. ("Kassan," U.S. Pub. No. 2002/0161717). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations. Applicant discusses the rejections in the following.

A. The Kujirai Disclosure

Kujirai discloses a print control apparatus for generating accounting information relating to a print job. Kujirai, Patent Title. As is described in the reference, the Kujirai system includes a "job accounting client application" that monitors a system spooler and acquires information relevant to accounting such as the number of sheets discharged by a printer to print the user's print job. Kujirai, column 5, lines 34-39. Later in the disclosure, Kujirai states that "information" is transferred from the user's printer driver to the job accounting client application 205, and that that information includes a "job identifier 402." Kujirai, column 7, lines 30-51.

B. The Kassan Disclosure

Kassan discloses a method and system for correlating job accounting information with software license information. Kassan, Patent Title. More specifically, Kassan discloses a system that collects and maintains cost and usage data relative to a resource (e.g., system connect time) for purposes of charging users for use of the resource. Kassan, column 1, paragraphs 0002-0005. At one point in the disclosure,

Kassan states the following: “In yet another embodiment (G), the user-id is used to correlate license dialogs with job processing information.” Kassan, paragraph 0173.

C. Discussion of the Merits of the Rejection

Applicant’s claims describe methods and apparatus for correlating pre-print and post-print information regarding a print job. For example, independent claim 1 provides as follows (emphasis added):

1. A computer-implemented method, comprising:
associating a print job with a unique job identifier prior to
sending the job to a printing device;
obtaining pre-print information about the print job;
obtaining post-print information about the print job; and
*correlating the pre-print information and the post-print
information using the unique job identifier.*

As is indicated in claim 1, at least that claim describes associating a print job with a “unique job identifier”, “obtaining pre-print information”, “obtaining post-print information”, and the “correlating the pre-print information and the post-print information *using the unique job identifier*” (emphasis added).

In the Office Action, the Examiner argues that Applicant admits that obtaining pre-print information, obtaining post-print information, and correlating the pre-print and post-print information is known, but that Applicant does not admit that correlating the pre-print and post-print information using a unique job identifier is known. For that missing teaching, the Examiner relies upon Kujirai and Kassan. Regarding Kujirai, the Examiner argues that Kujirai teaches “associating a job identifier with a print job when

spooling the print job.” Regarding Kassan, the Examiner argues that Kassan teaches “correlating information based on an identifier.”

Applicant notes that, even if all of the above Examiner arguments are presumed to be true, the combination of Applicant’s alleged admissions, Kujirai, and Kassan would *still* not support a proper case of obviousness under 35 U.S.C. § 103. Applicant describes the reasons for this conclusion in the following.

1. No Motivation to Combine Exists

As a first matter, Applicant submits that there is absolutely no proper motivation to combine the teachings of Kunirai and Kassan with the process of collecting pre-print and post-print information. As is noted above, both Kujirai and Kassan pertain to accounting systems, i.e., systems that track use of a resource for purposes of charging the user for that use. The alleged Applicant admissions say nothing about accounting.

Given the lack of a suggestion or motivation contained in the prior art for the proposed combination, it appears clear that the only suggestion or motivation comes from Applicant’s own claims. As is well established in the law, such hindsight to the Applicant’s own disclosure or claims is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention).

2. Applicant's Claims Being Considered in a Piecemeal Fashion

As a second matter, it appears clear that Applicant's claims are being considered in a piecemeal fashion. In other words, the Office Action identifies various references, each purportedly teaching a discrete element of Applicant's claims. What is missing, however, is an overall teaching that actually ties the teachings of the references together. As is well established in the law, the Examiner must consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). Accordingly, the Examiner cannot simply piece together multiple references to separately account for each explicit limitation in an effort to come up with a rejection.

When Applicant's claims are considered as a whole, it becomes clear that the proposed combination does not render Applicant's claims obvious. Even assuming there were an adequate teaching or suggestion to combine the references, such combination would still not result in Applicant's claimed inventions. For example, even though Kujirai mentions a "job identifier" used for accounting purposes and Kassan teaches a "user-id" that is used to correlate "license dialogs" with "job processing information," the fact remains that these teachings do not render obvious "correlating the pre-print information and the post-print information using the unique job identifier" as is explicitly recited in Applicant's claim 1 (similar recitations are contained in other claims). *Nothing* in either reference contains the "missing link" that would inspire a person having ordinary skill in the art to make the modifications

to the alleged admitted system required to arrive at Applicant's claimed inventions in the manner suggested in the Office Action.

3. The Missing Teaching Comes from Applicant's Disclosure, Not the Prior Art

As a third matter, it is clear that the only teaching of "correlating the pre-print information and the post-print information *using the unique job identifier*" (emphasis added) comes from Applicant's own disclosure. In other words, there is nothing in the prior art, or in Applicant's Background section, that would teach or suggest to a person having ordinary skill in the art to use Kujirai's job identifier to correlate pre-print and post-print information. Furthermore, there is nothing in the art, or in Applicant's Background section, that would suggest to such a person to use Kassan's teaching as to correlating "license dialogs" with "job processing information" to correlate pre-print and post-print information using a job identifier. It is Applicant's *own disclosure*, which is not admitted as prior art, that actually provides the missing teaching. Without that teaching, a person having ordinary skill would simply not arrive at the claimed invention.

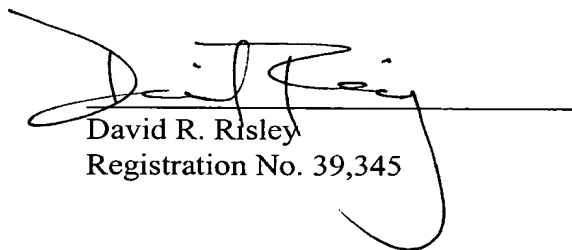
4. Conclusion

In view of the above, Applicant respectfully submits that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over Kujirai and Kassan and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

10-21-05

Mary Meepa
Signature